



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

7590 02/15/2011
William S. Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

EXAMINER

GIARDINO JR, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

2185

MAIL DATE	DELIVERY MODE
-----------	---------------

02/15/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,871	Applicant(s) MUKAIHARA ET AL.	
	Examiner MARK A. GIARDINO JR	Art Unit 2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/13/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Examiner acknowledges the applicant's submission of the amendment dated 12/3/2010. At this point claims 9, 11, and 13 have been amended.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT

Information Disclosure Statement

As required by **M.P.E.P. ' 609 (C)**, the applicant's submission of the Information Disclosure Statement, dated 8/13/2010, is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by **M.P.E.P. ' 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

CLAIM OBJECTIONS

Claims 9-15 are objected to because of the following informalities:

Claims 9, 11, and 13 contain unclear grammar from the phrase "having GUI function". The claim has been interpreted as "having a GUI function". Appropriate correction is required.

REJECTIONS NOT BASED ON PRIOR ART

a. DEFICIENCIES IN THE SPECIFICATION

Specification

The newly added limitations of “wherein when at least one of the reproduction program data and the execution program data is installed in the host machine and the portable memory device is connected to the host machine, the host machine writes at least one of said image data and audio data using the writing program and outputs the writing program having GUI function, the reproduction program data and the execution program data to the portable memory device” prompted further examination of the specification for clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description to comply with 37 CFR 1.75(d). Also see MPEP 608.01(o)[R-3].

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Examples of non-idiomatic English and improper grammar include:

Paragraph 0002: “program data for reproduction, editing and the like of an image file by using PC is stored beforehand on a digital camera side so that this program is not required to be installed in PC”. It is unknown what a “digital camera side” is.

Paragraph 0007: “the host machine is a machine having a computer function”.
What is a computer function?

Paragraph 0007: "These are applied also to the following description". What is meant by "these" is unclear.

Paragraph 0012: The list of steps includes two step (a)'s but not a step (b).

Paragraph 0038: "CPU 2 opens a fundamental screen". What is meant by "fundamental" in this context?

Paragraph 0039: The abbreviation BGM is used without first explaining what this term means, and the phrase "back music button" is believed mean "background music button".

Paragraph 0041: "the user may store once the files in HDD 4 of PC 1 as a user designated folder". What this phrase means is unclear.

Various other instances of unclear grammar and non-idiomatic English exist.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. 37 CFR § 1.75 (d)(1) requires that the claim(s) must conform to the invention as set forth in the remainder of the specification and that the terms and phrases used in the claims must find clear support or antecedent basis in the description, so that, the meaning of the terms may be ascertainable by reference to the description.

The newly added limitation in independent claims 9, 11, and 13 "a writing program having GUI function" is not adequately described in the drawings or specification. The "writing program" is not mentioned in the specification. The support for the amendment given by applicant contains a "data write program", but adequate

Art Unit: 2185

written description has not been given indicating that the “data write program” in the specification corresponds to the claimed “writing program”.

b. DEFICIENCIES IN THE CLAIMED SUBJECT MATTER

Claim Rejections - 35 USC ' 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation in independent claims 9, 11, and 13 “a writing program having GUI function” is not adequately described in the drawings or specification. The “writing program” is not mentioned in the specification. The support for the amendment given by applicant contains a “data write program”, but adequate written description has not been given indicating that the “data write program” in the specification corresponds to the claimed “writing program”.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

Art Unit: 2185

which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 recites "the host machine...outputs the writing program having GUI function, the reproduction program data and the execution program data to the portable memory device" in the newly added limitations of the claim. However, other claim limitations indicate that the reproduction program data and execution program data are already stored on the portable memory device (e.g., lines 4-12 of the claim). Also, lines 17-21 claim 9 indicate that the portable memory device installs the reproduction program data and the execution program data onto the host machine, further leading one of ordinary skill in the art to believe that the reproduction program data and execution program data are already stored on the portable memory device. Thus, one of ordinary skill in the art would not know how to make and/or use the invention, as how the host machine outputs the writing program data and reproduction program data when the portable memory device already contains such data would not be known. Claims 11 and 13 have a similar issue.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 11, and 13 use the acronym "GUI" without first expressing what the acronym is abbreviating. Appropriate correction is required.

Claim 9 recites "the host machine...outputs the writing program having GUI function, the reproduction program data and the execution program data to the portable memory device" in the newly added limitations of the claim. However, other claim limitations indicate that the reproduction program data and execution program data are already stored on the portable memory device (e.g., lines 4-12 of the claim). Also, lines 17-21 claim 9 indicate that the portable memory device installs the reproduction program data and the execution program data onto the host machine, further leading one of ordinary skill in the art to believe that the reproduction program data and execution program data are already stored on the portable memory device. Thus, it is unclear to one of ordinary skill in the art what is happening when the host machine outputs the reproduction data and execution program data to the portable memory device. Are the programs being updated? Is the host machine sending a duplicate copy of the data to the portable memory device? Appropriate correction is required. Claims 11 and 13 have a similar issue.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Rejections - USC 102/103

Applicant's argument regarding the prior art rejections have been considered and are persuasive, thus the prior art rejections have been withdrawn. However, various issues regarding 35 U.S.C. 112 have been introduced as noted *supra*.

CLOSING COMMENTS

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. ' 707.07(i)**:

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a second action on the merits and are subject of a second action final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the

Art Unit: 2185

examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272 - 4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino

/M.G./

Patent Examiner
Art Unit 2185

February 14, 2011

**/Stephen Elmore/
Primary Examiner**
Art Unit 2185